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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Yoshiko Amitani

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KRATZ, QUINTOS & HANSON, LLP
1420 K Street, N.W.
Suite 400
WASHINGTON, DC 20005

EXAMINER

NGUYEN, JIMMY H

ART UNIT

PAPER NUMBER

2629

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DELIVERY MODE

12/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/807,178	Applicant(s) AMITANI ET AL.	
	Examiner JIMMY H. NGUYEN	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is made in response to applicant's amendment filed on 10/15/2008.

Claims 1-3 and 5 are currently pending in the application. An action follows below:

Specification

2. The amendment filed 10/15/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

(i) “[I]n the example of the invention ... substantially the **entire area** of the front surface of the first case is covered (Fig. 2) ... Although only this one example is shown, the present invention also considers arrangements in which the second case **may only cover a part area** of the front surface of the first case when closed. In the present invention, at least a part area of the front surface of the first case is covered when the second case is closed to the first posture.” is newly added; see page 3 of the amendment; and

(ii) “[I]n the example of the invention ... substantially the **entire area** of the front surface of the first case is covered (Fig. 5) ... Although only this one example is shown, the present invention also considers arrangements in which the second case **may only cover a part area** of the front surface of the first case when closed. In the present invention, at least a part area of the front surface of the first case is covered when the second case is closed to the first posture.” is newly added; see page 4 of the amendment;

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

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3. Claim 5 is objected to because of the following informalities: “the **first** surface” in line 9 should be changed to -- the **front** surface -- so as to make the claimed feature consistent with the feature in line 8. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Castiel (US 6,249,672 B1).

As to claim 5, Castiel discloses a portable wireless terminal (a portable telephone; Fig. 1A) comprising a first case (a module 104; Fig. 1A) having a front surface (a surface having a keyboard 120 and arrow keys 125; Fig. 1A) and a rear surface (a rear surface of module 104; Fig. 1B), a second case (a module 102; Fig. 1A) having a front surface (a surface having a display 114; Fig. 1A) and a rear surface (an inner surface of module 102, which is between the display 114 and the front surface of the module 104; Fig. 1A), and an interconnecting mechanism comprising a sliding mechanism for slidably interconnecting the first case (104) and the second case (102) to one another (by virtue of the sliding operation described at col. 2, line 61 through col. 3, line 6), wherein the two cases (102,104) are slidably lapped over one another with the front surface of the first case (104) opposed to the rear surface of the second case (102), the second case (102) connects to the first case (104) by the interconnecting mechanism so that the second case (102) is closable to a first posture (Fig. 3) wherein at least a part area (an area

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including key 120) of the front surface of the first case (104) is covered (Fig. 3) and is openable to a second posture (Fig. 1A) wherein said at least a part area (an area including key 120) of the first surface of the first case (104) is exposed (Fig. 1A), the front surface of the second case is provided with a display (114), the first case (104) having a pointing device (arrow keys 125; Fig. 1A) projecting therefrom in a direction apart from the front surface of the first case for input manipulation on a screen presented on the display (Fig. 1B), the second case (102) having an opening extending through the second case from the front surface thereof to the rear surface thereof at the position opposed to the pointing device when in the first posture (Fig. 3), and the opening is formed by a notch having a U-shaped opening opposed to the pointing device (125) (Fig. 3).

Accordingly, all limitations of this claim are read in the reference.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sassi (US 6,487,396 B1) and further in view of Nguyen (US 5,797,089).

As per claim 1, Sassi discloses a portable wireless terminal (an electronic device 1; Fig. 1 or 2) comprising a first case (the housing part 2; Fig. 2) having a front surface (an inner surface 2a; Fig. 2) and a rear surface (an outer surface 2b; Fig. 2), a second case (the second housing part 3; Fig. 2) having a front surface (an inner surface 3a; Fig. 2) and a rear surface (an outer surface

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3b; Fig. 1), and an interconnecting mechanism (a hinge 4; Fig. 2) for interconnecting the two cases (2, 3) (Fig. 2), the interconnecting mechanism comprising a hinge mechanism (4) for openably interconnecting the first case (2) and the second case (3), the second case (3) connecting to the first case (2) by the interconnecting mechanism (4) so that the second case (3) is closable to a first posture (a close position; Fig. 1) wherein at least a part area of the front surface (2a) of the first case (2) is covered (Fig. 1) and is openable to a second posture (an open position; Fig. 2) wherein said at least the part area of the front surface (2a) of the first case (2) is exposed (Fig. 2), the front surface (3a) and rear surface (3b) of the second case (3) being provided with respective displays (5a, 6a; Figs. 1-2), the second case (3) having an opening (3c) extending through the second case (3) from the front surface (3a) thereof to the rear surface (3b) thereof at the position opposed to the pointing device (7/7a) when in the first posture (the closed position) (Figs. 1 and 1a), the opening (3c) having an inner peripheral wall to surround the entire pointing device (Figs. 1 and 1a).

Sassi teaches the second case (3), but not the first case, having the pointing device (7/7a) for input manipulation on a screen presented on the displays (col. 8, lines 53-63). Accordingly, Sassi discloses all limitations of this claim except that the pointing device is included in the second case, instead of the first case, as presently claimed.

However, Nguyen discloses a related portable terminal (a personal communications terminal 10; Fig. 2) comprising a first case (22) and a second case (21) and the first case (22) having a pointing device (an optical trackball projecting therefrom in a direction apart from the front surface of the first case (22) for input manipulation on a screen presented on the display (col. 4, lines 20-22). Therefore, it would have been obvious to a person of ordinary skill in the art

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at the time of the invention was made to locate the Sassi pointing device in the first case as a matter of design choice, in view of the teaching in the Nguyen reference. Further, it has been recognized in the art that whether the pointing device is located in the Sassi first housing (2) or the Sassi second housing (3), such that the pointing device is at the position opposed to the opening (3c) when in the first posture (the closed position), the pointing device is capable of controlling the cursor on a screen presented on the displays (5a, 6a). Moreover, it has been recognized in the art that when the device is in the second posture (i.e., open position as shown in Fig. 2), the user comfortably holds the device by grasping the left and right sides of the first housing (2) with the left and right hands, for operating the keyboard. Therefore, the user comfortably operates the pointing device and the keyboard without reaching farther to the second housing (3).

As to claim 2, Sassi further teaches that the pointing device can be in the form of a stick (i.e., the claimed bar) and is movable so as to tilt upwardly, downwardly, rightwardly or leftwardly with its base end serving as a fulcrum (col. 7, lines 8-14 and lines 43-59).

As to claim 3, Sassi discloses that wherein the front surface (3a) of the second case (3) is opposed to the front surface (2a) of the first case (2) in the first posture (the closed position) (Fig. 1); in the meantime, the front surface (3a) of the second case (3) is apart from the front surface (2a) of the first case (2) in the second posture (the open position) (Fig. 2), the pointing device (7/7a) functions for a screen presented on the display (6a) disposed on the rear surface (3b) of the second case (3) in the first posture (the closed position) (see Fig. 1; col. 6, lines 39-48); in the meantime, the pointing device functions for a screen presented on the display (5a) disposed on

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the front surface (3a) of the second case (3) in the second posture (the open position) (Fig. 2; col. 6, lines 39-48).

Response to Arguments

8. It is noted Applicant that the claim objection, the drawing objection and the rejections under 35 USC 112, first and second paragraphs, in the previous Office action dated 07/22/2008, have been rendered moot in light of the amendments to independent claims 1 and 5. These objections and rejections in the previous Office action dated 7/22/2008 are hereby withdrawn. However, upon further consideration, the new grounds of rejections are made above.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is 571-272-7675.

The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jimmy H Nguyen/

Primary Examiner, Art Unit 2629